

REMARKS

Upon entry of this response, claims 7-17 and 22-34 are pending. Claims 1-8 and 18-21 were canceled in a prior response. Claims 7-10, and 12 have been amended. No new matter has been added by way of this response.

Elections and Provisional Elections

In the Restriction Requirement of August 8, 2006, the Office required the election of "C. Whereby the enzyme contains: x. diaphorase [or] y. diaphorase and dehydrogenase". In the Response of February 8, 2007, Applicants elected species C(y), which is diaphorase and dehydrogenase, specifying that claims 10-12 and 34 are readable on the C(y) elected species. Applicants note that the prior species election complied precisely with the Office's request.

In the present Notice of Non-Compliant Amendment, the Office has amended the required species election of ¶4, Part C. The Office now requires election of:

C(a). One enzyme selected from the group consisting of (i) diaphorase, (ii) dehydrogenase, (iii) NADH, (iv) other enzyme, specify the enzyme, or (v) any enzyme would be enabling to practice the instant invention.

C(b). Two enzymes selected from the group consisting of: (i) diaphorase and dehydrogenase, (ii) diaphorase and NADH, (iii) dehydrogenase and NADH, (iv) any two enzymes; or (v) any combination of the above which includes any one or two enzymes would be enabling to make and practice the instant invention.

C(c). Three enzymes selected from the group consisting of: (i) diaphorase and dehydrogenase and NADH, (ii) any three enzymes, specify enzymes, or (iii) any three enzymes would be enabling to make and practice the instant inventions.

C(d). Four or more enzymes-please specify the enzymes. (i) please specify the number of enzymes required to practice the instant inventions and required to make and practice the instant inventions-specify those required of the four or more enzymes to practice the instant invention; or (ii) any four enzymes would be enabled to make and practice the instant inventions.

C(e). Any variation of the above-please specify the variation.

In response to the Office's amended species restriction C(a-e), Applicants provisionally elect species C(b), which is "two enzymes". Claims 10-11 and 34 are readable on the C(b) elected species and are hereby designated for further examination.

While the amended species restriction is not entirely clear, Applicants presume that the Office also intended to require a sub-species restriction of C(b)(i-v). If this presumption is correct, Applicants provisionally elect sub-species C(b)(i), which is "diaphorase and dehydrogenase". Claims 10-11 and 34 are readable on the C(b)(i) elected sub-species and are hereby designated for further examination.

The Office asserts that the arguments on pages 12-14 of the February 8, 2007 response are not drawn to appropriate grounds because the species requirement is not a restriction requirement and that it is sufficient for the Office to support a species requirement with the assertion that the species are patentably distinct. But the Office must demonstrate a serious burden if restriction is not required for all restrictions, including both invention group restriction and species restriction. In §808.01(a), the MPEP provides that a "requirement for restriction is permissible if there is a patentable difference between the *species* as claimed and *there would be a serious burden on the examiner if restriction is not required*" (emphasis added). Here, the Office has asserted that the species are independent and/or distinct—This is only part of the showing required of the Office. As such, Applicant reassert their prior traversal of the Office's species restriction requirement based upon the Office's failure to show a serious burden in not making the restriction.

In electing the species referenced below, Applicants hereby request REJOINDER of all non-elected species claims upon allowance of any generic claim. The Office asserts that Applicants improperly request rejoinder. Under §808.01(a), directed toward species restriction practice, the MPEP requires that "[i]n all applications where a generic claim is found allowable, the application should be treated as indicated in MPEP § 809 and § 821.04(a)." Applicants respectfully direct the Office to: Form ¶8.45 of MPEP §821.04(a) (see Examiner Notes 2 and 6).

CONCLUSION

Applicants believe that the claim as presented represents allowable subject matter. If the Examiner desires, Applicants welcome a telephone interview to expedite prosecution. As always, the Examiner is free to call the undersigned at the number below. Applicants believe there is no fee due at this time. The Commissioner is hereby authorized to charge any applicable fees to Deposit Account No. 19-3140.

Respectfully submitted,

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